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Serial No.: 10/030,718  
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### Remarks

Please enter into the record the amendments set out above. These amendments do not require a new search. Claim 1 and claim 2 have been consolidated and the material added to claim 1 from claim 2 should not trigger a new search on the now more limited scope of claim 1. Amendments of an editorial nature have been made to claims 4 - 6, 9 and 19.

### Claim Rejection Under 35 USC §112 ¶2

Claims 1 - 6, 9 and 19 have been rejected under 35 USC 112 ¶2 on several grounds. Each will be treated in the order set out in the examiner's paper beginning on page 2.

Claim 1 is said to be confusing in so far as the examiner appears to be unclear what comprises the decarboxylation process/product combination.

Claim 1 is directed to producing a mono-carboxyl group on the cyclohexane ring by heating the di-acid or di-ester, or mixed di acid/ester under certain conditions. See page 8 beginning at line 4 of the specification and Example 7, which illustrates the specific case. While applicants' use of the phrase "R' and R" are independently hydrogen or CO(O)X where X is hydrogen or C<sub>1-6</sub>alkyl" was intended to convey this point, applicants are electing to revise that phrase to state that one of the R' groups must be hydrogen and the other must be CO(O)X. If further clarification is requested please so state.

A second issue the examiner has with claim 1 is that, as filed, it recites a generalized process. Allegedly this generalized process is so general as to be indefinite. The examiner points to claim 2 as the first instance of specific conditions, which, while still general in scope place the reaction into the context of medium temperature pyrolytic process.

Applicants' elect to state the general conditions of claim 2 in claim 1 and delete claim 3. It is believed this merging of the conditions originally set out in claim 2 into claim 1 addresses the examiner's concerns.

As regards claim 4, it is alleged that the phrase "one group is substituted on at the 3 position and the other group is substituted on the 4 position" is indefinite.

Applicants have amended this claim herein above to specify that it is the benzene ring of formula (I), which is in issue. Two grammatical errors in the previous version of this claim have also been addressed as well.

Claim 9 is said to be indefinite on the basis of the phrase "A compound according to any one of claims 7.

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Applicants have corrected this error by amending the claim to read "... (A)ccording to claim 7 ... ."

Claim 19 is said to be indefinite on the basis of the phrase "a compound according to claim 17" in light of the fact claim 17 is a process claim:

Applicants have amended claim 19 to read "The process of claim 17 ... ." bringing it into parity with the type of claim that is claim 17.

#### Rejection Under 35 USC §102(b)

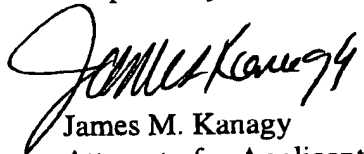
Claims 10, 11, 13, 14 and 16 have been rejected as being anticipated by Dei et al, J. Med. Chem., 1991, 34(7), pp 2219-2225. Dei is said to disclose a process for making verapamil which process uses benzeneacetonitrile, alpha-bis(2-hydroxyethyl-3,4-dimethoxy; benzene acetonitrile, alpha, alpha-bis[(ethenyloxy)ethyl]-3-4-dimethoxy and benzeneacetonitriles; and benzene acetonitrile, alpha, alpha-bis(2-chloroethyl-3-4-dimethoxy.

Applicants have cancelled these four claims above. So this rejection is moot.

#### Conclusion

Please enter the proposed amendments to the claims into the record. Please allow all extant claims.

Respectfully submitted,



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